

applicant's rejection traversal, and therefore assumes that the absence of any comments regarding §1.130 was an inadvertent omission.

Pursuant to CFR §1.130(a), where judicially-created double patenting applies for a commonly owned patent, the patent can be obviated as prior art by: a timely-filed terminal disclaimer in accordance with CFR §1.321, and a declaration that the application and the patent are commonly owned by the same party and that the inventive entity named on the application is the prior inventive entity. With regard to Applicant's terminal disclaimer requirement under CFR §1.321, Applicant disclaimed and dedicated to the public that terminal part of any patent issuing from the above-referenced application which extends beyond the expiration date of U.S. Patent No. 5,836,566, as it and the application are commonly owned by the applicant, as stated in the *Terminal Disclaimer under §1.321 and Declaration under §1.130*. Thus, the only issue apparently at hand is whether Applicant has satisfied the requirement that the inventive entity named on the application is the prior inventive entity.

Assuming *arguendo* that the § 103 and double patent rejections are proper, Applicant submits that this requirement (that the inventive entity named on the application is the prior inventive entity) has been satisfied through the *Terminal Disclaimer under §1.321 and Declaration under §1.130* when considered with the respective Declarations filed by the inventors in connection with the filing of the instant application and the filing of the prior patent. Applying MPEP § Sections 715.02 and 715.03, when determining the priority entitlement to the various inventors, the issue turns on whether the inventor had "possession of the invention (i.e., the basic inventive concept)," and, assuming any differences would have been obvious, the "differences between the claimed invention and the showing" are unimportant. Thus, in this instance, the "differences between the claimed invention and the showing" of the prior patent have been deemed to be unimportant (i.e., the obvious rejections); thereby deeming that the two inventors that signed the declaration filed in connection with the prior patent are the inventors of the subject matter commonly-claimed and the basis for the recently-withdrawn double patenting rejection. In other words, the *Terminal Disclaimer under §1.321 and Declaration under §1.130* satisfies the §1.130 requirement regarding common inventive entity (see bottom of page 1 of the *Terminal Disclaimer under §1.321 and Declaration under §1.130*).

In view of the application of §1.130, Applicant submits that the final rejection should be withdrawn and that all of the claims are now in condition for allowance. Reconsideration and withdrawal of the rejections, along with a favorable response, are earnestly requested.

Regarding the note at the bottom of the Advisory Action and the representative capacity of the undersigned attorney, the file history has been reviewed and Applicant can find no record of any challenge to the current representative capacity of the undersigned attorney, as would be required under Rule 1.34. Thus, Applicant has resubmitted herewith a Change of Address form and requests that future correspondence be mailed accordingly.


Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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By:


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